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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,429	03/31/2004	Masahiro Abe	58799-109	3795

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MCDERMOTT, WILL & EMERY  
600 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER
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JARRETT, SCOTT L

ART UNIT	PAPER NUMBER
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3623

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/813,429	<b>Applicant(s)</b> ABE ET AL.	
	<b>Examiner</b> SCOTT L. JARRETT	<b>Art Unit</b> 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/31/2004</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This Non-Final Office Action is in response to Applicant's submission filed March 31, 2004. Currently Claims 1-10 are pending.

#### ***Title***

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: System for Controlling Workflow Between Customers and Bank Branches.

#### ***Claim Objections***

3. Claims 1-10 are objected to because of the following informalities. Appropriate correction is required.

Regarding Claim 1, the system as claimed merely '*can be* operated by a sales person', however the system is not actually operated by a sales person. For the purposes of examination examiner assumes the applicant will amend the claim to recite that system is actually operated by a sales person.

Regarding Claims 1 and 6, the claims recite the abbreviation I/O. Applicant is requested to 'spell-out' any abbreviations in the claims at least the first time the abbreviation is recited (e.g. Input/Output (I/O)).

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims, as currently recited, appear to be directed to a system components without any tangible result and are therefore deemed to be non-statutory while the compilation of system components may have some real world value (i.e. utility/usefulness) there is no requisite functionality present to satisfy the practical application requirement nor are there any “acts” which transform the data and/or cause a physical transformation to occur outside the computer (i.e. not concrete or tangible) therefore the invention as claimed does not produce a useful, concrete, and tangible result.

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does not make it statutory. See *Diamond v. Diehr*, 450 U.S. 175, 185-86, 209 USPQ 1, 7-8 (1981) (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”). Such a result would exalt form over substance. In re *Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) (“[E]ach invention must be evaluated as claimed; yet semantogenic considerations

Art Unit: 3623

preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.") (Abele, 684 F.2d 902, 907, 214 USPQ 682, 687(CCPA 1982)). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under copyright law.

A claimed invention is deemed to be statutory, if the claimed invention produces a useful, concrete, and tangible result. An invention, which is eligible for patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "use, concrete and tangible result". See AT&T v. Excel Communications

Inc., 172 F.3d at 1358, 50 USPQ2d at 1452 and State Street Bank & Trust Co. v.

Signature Financial Group, Inc., 149 F.3d at 1373, 47 USPQ2d at 1601 (Fed. Cir. 1998). The test for practical application as applied by the examiner involves the determination of the following factors"

(a) "Useful" - The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

i. the utility need not be expressly recited in the claims, rather it may be inferred.

ii. if the utility is not asserted in the written description, then it must be well established.

(b) "Tangible"-Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" - Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

In the present case, claims 1-3 merely recite a system for controlling a workflow. While the invention may be concrete and/or useful, there does not appear to be any tangible result.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claim 1, Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the controlling of a workflow. The preamble of claim 1 recites that the system is for controlling a workflow however none of the recited components actually control a workflow as recited in the preamble.

Regarding Claim 4, Claim 4 recites the limitation "said branches" in claim 3. There is insufficient antecedent basis for this limitation in the claim. For the purposes of examination the examiner interpreted claim 4 to read 'for each branch.'

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Dhar et al., U.S. Patent Publication No. 2002/0040312

Regarding Claim 1 Dhar et al. teach a system for controlling a workflow comprising (Figure 3):

- a plurality of operation terminals (units, computers, devices, ATMS, etc.) that are operated by a customer or sales person (e.g. web browsers; Paragraphs 0017, 0026-0027; Figure 2);

- a plurality of processing devices (hardware, software, people, or combinations thereof; Paragraphs 0017, 0026-0027);

- a server to be access from the operational units (application server, web server; Paragraphs 0020, 0029; Figure 1, Element 14; Figure 2, Element 29);

- a work system to be access from the server (e.g. workflow engine; Paragraphs 0029, 0032; Figure 2, Element 20);

Art Unit: 3623

- wherein the plurality of operational terminals and processing devices are installed in a branch (business location, office, etc.) and the server/work system are installed in a computation center (location, office, etc.; Paragraphs 0026-0027; Figure 3);

- wherein the server comprises:

- a terminal unit input/output control unit which executes process to accept input data from the operation terminals and a process to generate a screen to be displayed on the operational units (web server, application server; Paragraphs 0029, 0040, 0047-0049, 0053, 0077, 0082-0083; Figures 2, 9A, 9B);

- a first component controlling the processing devices (Paragraphs 0072, 0118; Figures 4, 8);

- a second component allowing the work system to be accessed (application server, web server; Paragraphs 0020, 0029; Figure 1, Element 14; Figure 2, Element 29);

- a plurality of third components controlling work logics in the server (application service, business logic, rule, workflow engine, checklists, etc; Paragraphs 0031-0034, 0039, 0043; Figures 4, 8).

Regarding Claim 2 Dhar et al. teach a system wherein the server executes the first/second/third components in response to input data from the operational terminals (Paragraphs 0040, 0048-0049, 0053; Figures 5, 7, 9A, 9B).

Regarding Claim 3 Dhar et al. teach a system wherein the service includes a flow control unit controlling process flow using the first/second/third components (workflow engine, workflow designer; Figure 2, Element 20) wherein the flow control unit includes a management unit, managing definition information – defining the sequence of the components (workflow designer; Paragraphs 0030-0033, 0037, 0042; Figure 2, Element 24), and an engine - calling the components in accordance with the definition information (workflow engine; Paragraphs 0044, 0049; Figure 2, Element 20).

Regarding Claim 4 Dhar et al. teach a system wherein the definition information defines a series of workflow including switching of a plurality of screens to be displayed on the operation terminals so that a different sequence for each branch can be provided (e.g. branch specific rules/logic/parameters; Paragraphs 0028, 0043, 0059, 0064, 0066).

Regarding Claim 5 Dhar et al. teach a system wherein the first component includes management information for managing associations between the operation terminals and processing devices and wherein each operation terminal defines a processing device to be used by the operational terminal by referring to the management information (Paragraphs 0064, 0066, 0072, 0078; Figure 4).

Du et al., U.S. Patent No. 5,826,239

Regarding Claim 6 Du et al. teach a system for controlling workflow comprising:

- storing flow management information defining a processing for work according to a request from the operation terminals, in a storage device (Column 6, Lines 30-35; Column 7, Lines 56-58; Figure 2, Elements 21, 26-27; Figure 4, Elements 63, 21; Figure 5, Element 21);
- controlling input and outputs of data from the operation terminals, via a terminal I/O control unit (Column 4, Lines 44-45; Column 6, Lines 40-49; Figures 4, 6);
- a plurality of device management units provided for the types of processing units which controls the devices (e.g. resource managers, application data handlers; Column 6, Lines 40-49; Column 10, Lines 48-57; Column 15, Lines 23-28; Column 20, Lines 31-48);
- discriminating work, via a flow control unit, according to a request from each of the operation terminals, defining a processing flow satisfying the work by referring to flow management information in the storage device and defining the device management unit to be operated out of the plurality of device management units based on the processing flow (Column 2, Lines 37-59; Column 4, Lines 60-68; Column 9, Lines 36-45).

Du et al. further teach that the system comprises processing work according to requests from the operation terminals/units (Column 9, Lines 36-41; Column 21, Lines 15-39) and that the terminals connected via a network located in a plurality of locations including inside and outside of a business location (e.g. branch; Global/Local management of resources; Column 2, Lines 60-68; Column 3, Lines 1-20; Figures 1, 2).

Regarding Claim 7 Du et al. teach a system wherein the storage device stores information identifying a branch (site, location, office, etc.) in which the processing devices are arranged (located, reside, installed, etc.; e.g. address, organization unit; Abstract; Column 10, Lines 38-41; Column 13, Lines 43-46); and

- wherein the device management unit, by referring to the identification information, selects a processing device installed in the same branch (location) as the branch that made the request to the terminal and controls the selected processing device (e.g. utilizes local resource in same resource group or managed by local resource manager; Column 4, Lines 59-68; Column 5, Lines 1-7; Column 13, Lines 32-57).

Regarding Claim 8 Du et al. teach a system wherein the storage processing device stores occupancy status; and wherein the device management unit selects an unoccupied processing device based on its stored occupancy status and controls the selected device (Column 2, Lines 49-53; Column 4, Lines 58-68; Column 13, Lines 43-57; Column 15, Lines 50-59; Column 19, Lines 28-37).

Regarding Claim 9 Du et al. teach a system wherein the storage device stores association information between the operation terminals and processing devices (Column 10, Lines 48-53; Column 13, Lines 48-58; Column 14, Lines 60-63; ; and wherein the device management unit judges (determines) if the processing device, associated with the operation terminal that made a request, is available or not and controls the processing device if it is available and selects another processing device to be operated if the processing device is unavailable (Column 2, Lines 49-53; Column 4, Lines 58-68; Column 13, Lines 43-57; Column 15, Lines 50-59; Column 19, Lines 28-37).

Regarding Claim 10 Du et al. teach a system wherein the flow control unit selects a type of processing device to be operated according to the processing flow and selects a device management unit which is adequate for the type of processing device to be operated (Column 2, Lines 49-53; Column 4, Lines 58-68; Column 13, Lines 43-57; Column 15, Lines 50-59; Column 19, Lines 28-37).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Saito et al., U.S. Patent Publication Nos. 5,867,824 and 6,032,124, teach a system and method for controlling workflow.
- Brumbelow et al., U.S. Patent No. 6,119,104, teach a system and method for controlling workflows at a bank branch comprising a plurality of operation terminals used by customers or sales persons; a plurality of processing devices installed inside and outside the branch; a server accessed by the operation terminals; and components from controlling the processing devices and work logic associated with the operation terminals.
- Francis et al., U.S. Patent No. 6,772,131, teach a system and method for controlling a workflow in a finance/banking environment comprising: workload balancing, resource available determination, a plurality of processing devices and operation terminals, and controlling screens displayed on the terminals.
- Fei et al., U.S. Patent Publication No. 2003/0040959, teach a system and method for controlling workflow, located outside a branch to which a customer makes a visit, which system is connected via a network to a plurality of operation terminals and processing devices wherein the processing devices process work according to work from the operation terminals.

Art Unit: 3623

- Coffey, Going With The Flow (2001), teaches the well known utilization of workflow management and bank branch automation systems and method to control banking related workflows.

- SDInc.com Web Pages (2000), teaches a commercially available system and method for bank branch automation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT L. JARRETT whose telephone number is (571)272-7033. The examiner can normally be reached on Monday-Friday, 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boswell Beth can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/813,429  
Art Unit: 3623

Page 15

/Scott L Jarrett/  
Primary Examiner, Art Unit 3623